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PATENT
Attorney Docket No.: 1020/0132PUS1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: GLIENICKE, et al.	Conf. No.: 6146
Application No.: 10/721,358	Art Unit: 2875
Filed: November 26, 2003	
Title: CONTROL ELEMENT	Examiner: CHOI, Jacob Y

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**MS AF**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In addition to the Notice of Appeal which is being concurrently filed, Applicants respectfully request a Pre-Appeal Brief Conference to consider the issues raised in the Office Action dated August 18, 2006, that finally rejected claims 1-19.

I. Glienicke Fails to *Prima Facie* Anticipate Claims 1, 2, and 4-19

The Examiner has finally rejected claims 1, 2, and 4-19 under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,224,221 to Glienicke (“Glienicke”). Applicants submit that Glienicke fails to show each and every element of the rejected claims as required under §102.

A. Glienicke fails to disclose, at least, an “annular slot being formed to receive a projection extending from the scale,” as recited in claim 11.

The Examiner asserts that Glienicke shows “an optical light guide (e.g., 6, 11) having an annular slot (e.g. Figure 1) provided therein, the annular slot being formed to receive a projection extending (e.g., 9) from the scale.”¹ The Examiner further alleges, using an annotated version of Fig. 1, that the annular slot is the small vertical space between the peripheral part of light transmitting body 6 (indicated by reference number 8 on the left side of Fig. 1), and light

¹ Office Action mailed 8/18/2006; page 4, paragraph 5.

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transmitting body 11.² Applicants respectively submit that the Examiner is taking an unreasonably broad interpretation of the disclosure of Glienicke to maintain the rejection.

Applicants respectively submit it is clear from Fig. 1 that the annular slot does not receive a projection extending from scale 10, or from the scale's transparent housing 9. It is clear from Fig. 1 that the housing 9 fails to extend into the annular slot. The transparent housing 9 stops short of the upper end of the annular slot so that light may pass between light transmitting body 6 and light transmitting body 11 in an unimpeded manner.

If, as the Examiner purports, housing 9 extended into the annular slot, it would then undesirably extend into the light pathway between light transmitting body 6 and light transmitting body 11, and attenuate the light passing there-through, thereby rendering Glienicke inoperable. Applicants note that the fact that housing 9 is transparent, does not mitigate this fact, as the transparent housing would still undesirably attenuate light passing through the annular slot.

B. Glienicke fails to disclose, at least, "a scale substantially circumscribing the corona," as recited in claim 11.

The Examiner asserts that Glienicke discloses a "scale (e.g. 10) substantially circumscribing the corona and the rotary knob,"³ wherein the Examiner asserts that the corona is housing 9.

Glienicke clearly shows in Fig. 1 that the scale 10 is embedded in housing 9, and that housing 9 extends beyond the outer radial extent of scale 10. Because the housing 9 extends beyond scale 10, the scale cannot substantially circumscribe the housing. In fact, Glienicke shows the opposite, wherein the housing 9 circumscribes the scale 10. Accordingly, Glienicke fails to disclose a scale substantially circumscribing the corona.

² *Id.*; top of page 3.

³ *Id.*; page 4, paragraph 5.

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C. Glienicke fails to disclose, at least, “an annular slot, such that parts of the panel engage or project into the slot,” as recited in claim 1.

The Examiner asserted that “Glienicke shows that “parts of the panel engage (e.g., 9) or project into the slot.”⁴ Here, the Examiner is interpreting the housing 9 as a panel. Applicants submit that interpreting transparent housing 9 as panel is an unreasonably broad interpretation. *In arguendo*, if transparent housing 9 were interpreted as a panel, housing 9 fails to engage or project into the slot (as provided in the arguments above for the allowability of claim 11).

D. Glienicke fails to disclose, at least, that “the corona is illuminated in the night design as a luminous ring around the rotary knob and is not illuminated in the daylight design and thus very difficult or impossible to detect,” as recited in claim 4 (emphasis added).

In this rejection, the Examiner curiously asserted “[r]egarding claim 4, Glienicke discloses the corona may be illuminated as a luminous ring around the rotary knob as radios, air-condition units, and the like in motor vehicles being operated.”⁵ The Examiner clearly erred in the examination of claim 4 and summarily failed to address the feature underlined in the above quoted portion of this claim.

E. Glienicke fails to disclose, at least, “wherein the optical light guide and the light rotor are formed as a single piece,” as recited in claim 10.

The Examiner asserted “[r]egarding claim 10, Glienicke discloses the optical light guide and the light rotor are formed as a single piece”⁶ Applicants submit that in no part of the reference does Glienicke disclose the light rotor and the optical light guide are formed as a single piece. In fact, given the Examiner’s overly broad interpretation that the light rotor is the rotary knob (which Applicants respectfully and strongly disagree), if it were, as the Examiner asserts, formed as a single piece with light transmitting body 6 or 11, it would not be a “rotatable” knob.⁷

⁴ *Id.*; page 2, paragraph 2.

⁵ *Id.*; page 3, paragraph 3.

⁶ *Id.*; page 4, paragraph 4.

⁷ See Abstract.

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Docket No. 1020/0132PUS1**II. Zysnarski Fails to *Prima Facie* Anticipate Claims 1, 4-9, 16, and 17**

The Examiner has finally rejected claims 1, 4-9, 16, and 17 under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,590,174 to Zysnarski et al. ("Zysnarski"). Applicants submit Zysnarski fails to show each and every element of the rejected claims as required under §102.

A. Zynarski fails to disclose, at least, a "control element that has a combined scale and corona illumination, wherein the scale is a part of a panel," as recited in claim 1.

The Examiner refused to afford this feature weight because "the recitation occurs in the preamble."⁸ The Examiner alleges that the "preamble generally is not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness."⁹ The Examiner's allegation, however, are legally incorrect at least in this instance.

Applicants disagree with the Examiner's implication that the preamble only recites the intended use of a structure, and respectfully submit that the above quoted recitation is a structural feature, as it describes the structural relationship between elements in the control element. Applicants submit that this structural recitation in the preamble must be given patentable weight according to the following provision of the MPEP: "Any terminology in the preamble that limits the structure of the claimed invention must be treated as claim limitation."¹⁰

Moreover, Applicants submit that the body of claim 1 depends upon the preamble for completeness, as the antecedent for "panel" in the recitation "an optical light guide ... such that parts of the panel ..." is found only in the preamble.

⁸ *Id.*; page 10, paragraph 2.

⁹ *Id.*

¹⁰ 2111.02 (I) MPEP (eighth edition, August 2006); *Corning Glass Works v. Sumitomo Elec. USA Inc.* 868 F.2d 1251.

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Accordingly, because the preamble recites structural limitations, and because it provides an antecedent basis for the body of the claim, it must be afforded patentable weight.

III. Dependent Claims and Rejections thereof under 35 U.S.C §103

Claims depending from claims 1 and 11 rejected under §102 to Glienicke and/or Zynarski are allowable at least by virtue of their dependency from their allowable base claims.

Additionally, the Examiner rejected dependent claims 2, 3, and 10 under 35 U.S.C. §103(a) as being unpatentable over Zynarski. Applicants traverse this rejection as these claims depend from claim 1 which is allowable over Zynarski for the reasons described above.

IV. Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number listed, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 50-3828 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: November 20, 2006

Respectfully submitted,



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